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In re Application of:
HARLEY, Calvin, B., et al. : DECISION ON PETITION UNDER
U.S. Application No.: 10/562,374 : 37 CFR 1.47(a)
PCT No.: PCT/US2004/020277 :
International Filing Date: 23 June 2004 :
Priority Date: 23 June 2003 :
Attorney's Docket No.: 38797-8004.US00 :
For: COMPOSITIONS AND METHODS :
FOR INCREASING TELOMERASE :
ACTIVITY :

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 07 September 2006. Applicants have paid the required petition fee.

BACKGROUND

On 23 June 2004, applicants filed international application PCT/US2004/020277. The international application claimed a priority date of 23 June 2003, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 23 December 2005.

On 23 December 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 08 May 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date, and additional sequence listing materials were required.

On 07 September 2006, applicants filed a response to the Notification Of Missing Requirements (with required two-month extension fee). The response included payment of the required surcharge, sequence listing materials, and the "Petition Under 37 CFR 1.47(a)" considered herein. The petition seeks acceptance of the application without the signature of inventor David MILLER-MARTINI, whom applicants assert has refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have submitted the required petition fee, and the petition expressly states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration materials executed by five of the six named inventors and containing an unsigned signature block for the non-signing inventor. However, the declaration consists of one copy of page 1, one copy of page 2, and four different copies of page 3 (the signature page), each signed by a different inventor. The multiple copies of the signature page have been renumbered by hand, but the submission appears to be a compilation of a number of separately executed declarations. As such, the declaration is not acceptable under 37 CFR 1.497 (See MPEP § 201.03(II)(B): “Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.”). Applicants must provide a copy of the complete declaration executed by each of the cooperating inventors (with each such declaration satisfying 37 CFR 1.497 and including an unsigned signature block for the non-signing inventor) before item (3) can be considered satisfied.

Regarding item (4), MPEP section 409.03(d) states that “[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants not provided a firsthand statement, with supporting documentary evidence, confirming that a request for signature, with a copy of the complete application, was forwarded to the non-signing inventor's attorney. Applicants must provide such evidence before

it can be concluded that the non-signing inventor has refused to execute the declaration in the present application. Based on the above, item (4) is not satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy items (3) and (4) of a grantable petition, as discussed above. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application.
Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT,
Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents
of the letter marked to the attention of the Office of PCT Legal Administration.



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